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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,772	01/25/2001	Roger Edwards	C005	5011

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PATENT DEPARTMENT
MACROVISION CORPORATION
2830 DE LA CRUZ BLVD.
SANTA CLARA, CA 95050

EXAMINER

MOORTHY, ARAVIND K

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 03/18/2004

15

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/744,772

Applicant(s)

EDWARDS, ROGER

Examiner

Aravind K Moorthy

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-30 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 15 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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DETAILED ACTION

1. Claims 1-30 are pending in the application.
2. Claims 1-30 have been rejected.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/26/03 has been entered.

Response to Arguments

4. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

5. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim that depends from a dependent claim should not be separated by any claim that does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

Claim Rejections - 35 USC § 102

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Tholen et al U.S. Patent No. 5,867,462.

As to claims 1 and 12, Tholen et al discloses a method of copy protecting a digital audio compact disc carrying audio data and control data. Tholen et al discloses that the control data is encoded onto the compact disc [column 3 line 45 to column 4 line 13]. Tholen et al discloses that the copy protection method comprises rendering selected control data incorrect [column 4, lines 34-49]. Tholen et al discloses that the selected control data being inaccessible to, or not generally read by, an audio player, such that an audio player is able to play the audio data [column 9 line 63 to column 10 line 38]. Tholen et al discloses that the incorrect control data negatively effects the playability of audio in a data reader [column 10, lines 39-54].

As to claims 2 and 13, Tholen et al discloses that the control data encoded on the compact disc that has been rendered incorrect is navigation data [column 9, lines 50-62].

As to claims 3 and 14, Tholen et al discloses that the control data is provided in a Lead-In on the disc, and the incorrect control data is provided in the Lead-In, and identifies the position on the disc of the Lead-Out of the disc [column 5 line 65 to column 6 line 15].

As to claims 4 and 15, Tholen et al discloses that the control data in the Lead-In that indicates the Atime at the start of the Lead-Out is rendered incorrect [column 6, lines 16-31].

As to claims 5 and 16, Tholen et al discloses that the control data in the Lead-in shows the Atime at the start of the Lead-Out to be zero [column 10, lines 54-62].

As to claims 6 and 17, Tholen et al discloses that the control data in the Lead-In has a value for the Atime at the start of the Lead-Out that occurs during a first audio track on the compact disc [column 5, lines 44-54].

As to claims 7 and 18, Tholen et al discloses that the control data encoded on the compact disc defining the nature of the tracks is rendered incorrect, as discussed above.

As to claims 8 and 19, Tholen et al discloses a method of copy protecting a digital audio compact disc carrying audio data and control data, as discussed above. Tholen et al discloses that the control data is encoded onto the compact disc, as discussed above. Tholen et al discloses that the copy protection method comprising rendering selected control data incorrect, as discussed above. Tholen et al discloses that the selected control data being inaccessible to, or not generally read by, an audio player, such that an audio player is able to play the audio data, as discussed above. Tholen et al discloses whereas the incorrect control data negatively effects the playability of the audio data in a data reader, as discussed above. Tholen et al discloses that the control data encoded on the compact disc defining the nature of the tracks is also rendered incorrect, as discussed above.

As to claims 9, 20, 24 and 29, Tholen et al discloses that the data on the CD identifying the nature of the tracks incorrectly identifies each audio track as a data track [column 7, lines 22-53].

As to claims 10, 21, 25 and 30, Tholen et al discloses that the compact disc that is rendered incorrect is data in the Table of Contents (TOC) of the compact disc [column 5, lines 44-54].

As to claims 11 and 26, Tholen et al discloses that the control data encoded on the compact disc is altered, to render it incorrect, prior to mastering of the disc [column 4, lines 34-49].

As to claims 22 and 27, Tholen et al discloses that the control data encoded on the compact disc that has been rendered incorrect is timing data [column 8, lines 8-28].

As to claims 23 and 28, Tholen et al discloses that the control data encoded on the compact disc that has been rendered incorrect is navigation and timing data, as discussed above.

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Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aravind K Moorthy whose telephone number is 703-305-1373. The examiner can normally be reached on Monday-Friday, 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz R Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aravind K Moorthy
March 9, 2004


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100